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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,469

07/23/2003

Iftikhar Khan

1468

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747 W. WRIGHTWOOD AVE  
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EXAMINER

STIGELL, THEODORE J

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

05/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/604,469	<b>Applicant(s)</b> KHAN, IFTIKHAR	
	<b>Examiner</b> THEODORE J. STIGELL	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10,13,14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,13,14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

### ***Election/Restrictions***

The examiner made the restriction requirement final in the previous office action mailed on 11/13/2007. The applicant must petition the director to overturn the restriction requirement. Please see MPEP 818.03 (c) reproduced below.

#### ***37 CFR 1.144. Petition from requirement for restriction.***

***\*\*>After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).<***

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10, 13-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pell et al. (4,850,348) in view of Wood (GB 2,220,357). Pell discloses most of the limitations recited by the applicant. Pell does not specifically teach to include a reservoir comprising an entry compartment and a second compartment, wherein a grid operable to prevent obstruction of the vacuum by the obstructive material separates the compartments. Instead, Pell discloses a standard suction source (column 5, line 33). The examiner notes that the applicant has disclosed (see claims 12/14/2006) that the suction system can be used with a standard suction system. In the rejection of this claim set (see final rejection mailed 2/12/2007), the examiner noted this disclosure and made it part of the record that no patentable weight was being given to the reservoir. The applicant has never traversed this point. It is clear that the system would work just as well with a standard suction canister as it would with the claimed reservoir.

Wood discloses a suction catheter system that is designed to "remove blood, irrigation liquid, tissue debris and the like" during a surgical procedure. Wood discloses a suction catheter (11) connected to a reservoir (1) comprising an entry compartment (10) and a second compartment (20) separated by a grid (41) that is operable to prevent liquid or debris from entering the vacuum source (21). Wood further discloses a removable disc (18) to remove the suctioned material from the reservoir.

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the system of Pell with the suction reservoir (1) and grid (41) of Wood

to make a suction system that would prevent the obstruction of the vacuum source and thus ensure continuous suction.

Claims 10, 13-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph (5,819,723) in view of Wood (GB 2,220,357). Joseph discloses most of the limitations recited by the applicant. Joseph does not specifically teach to include a reservoir comprising an entry compartment and a second compartment, wherein a grid operable to prevent obstruction of the vacuum by the obstructive material separates the compartments. Instead, Joseph discloses a standard suction source (402).

Wood discloses a suction catheter system that is designed to “remove blood, irrigation liquid, tissue debris and the like” during a surgical procedure. Wood discloses a suction catheter (11) connected to a reservoir (1) comprising an entry compartment (10) and a second compartment (20) separated by a grid (41) that is operable to prevent liquid or debris from entering the vacuum source (21). Wood further discloses a removable disc (18) to remove the suctioned material from the reservoir.

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the system of Joseph with the suction reservoir (1) and grid (41) of Wood to make a suction system that would prevent the obstruction of the vacuum source and thus ensure continuous suction.

### ***Response to Arguments***

Applicant's arguments filed 2/12/2008 have been fully considered but they are not persuasive.

The examiner notes that the arguments presented on pages 15-20 of the applicant's latest response (filed 2/12/2008) are a duplication of the response filed on 9/13/2007. These arguments were presented against 102 rejections which no longer apply and therefore these arguments are now considered moot.

The examiner also notes that in the current 103 rejections of Pell et al. (4,850,348) or Joseph (5,819,723) in view of Wood (GB 2,220,357) the examiner contends that both Pell and Joseph disclose using standard suction canisters and that the applicant has disclosed (see claims 12/14/2006) that the catheter system can work with either the disclosed reservoir or "standard commercially available suction canisters". This disclosure has led the examiner to conclude that the recited reservoir works no better than a standard container which both Pell and Joseph disclose. The examiner first pointed this out in the final office action mailed on 2/12/2007. The applicant has yet to traverse this conclusion or provide arguments why the recited reservoir provides an advantage over the standard container. The applicant has also not refuted this point in the latest response. The examiner contends that this point was never traversed because it appears that the applicant regarded the novel concept of the invention to be the catheter's ability to suction the areas such as the oropharynx and distal bronchi and did not regard the suction source as the novel concept of the invention. However, the applicant, in the response filed on 9/13/2007, disclosed that one of ordinary skill in the art would recognize the length needed for a catheter to reach such areas. The examiner has included this summary of the prosecution to more

clearly show the applicant why the examiner does not regard the invention to be patentable.

*Pell et al. (4,850,348) in view of Wood (GB 2,220,357)*

In response to the combination of Pell in view of Wood, the applicant states that Pell has no structure or mechanical design to allow for suction. This is not true. Pell discloses on column 5, lines 27-34 that the connector (82) can be connected to a "suction source". Pell obviously contemplated using the device for suction as well as ventilation and therefore the examiner strongly disagrees with the applicant's assertion that one of ordinary skill in the art would not think of using the device for anything except ventilation. The applicant also argues that Pell has no function to suction the oropharynx or trachea. The examiner notes that this limitation is a functional limitation which the reference only has to be capable of performing. Since the device of Pell is inserted into the trachea (19) and is capable of being connected to a suction source, the device of Pell certainly meets these limitations.

The applicant appears to argue that Wood is not a valid piece of art to combine with Pell for two reasons; 1) Wood is not patented in this country and 2) the device of Wood is not analogous art. In response to the applicant's first argument, the origin of patent protection is not a relevant factor in disqualifying Wood as prior art. GB 2,220,357 is a published patent and would qualify as 102(b) art and therefore also qualifies as 103(a) art. In response to applicant's second argument that Wood is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the device of Wood is concerned with the same problem as that of the applicant's invention, namely separating debris that is suctioned from the body. One skilled in the art would recognize that Wood has already invented a reservoir with a grid to separate suctioned debris and that it would be obvious to use this reservoir with other suction systems such as Pell.

*Joseph (5,819,723) in view of Wood (GB 2,220,357)*

In response to the combination of Joseph and Wood, the applicant states that Joseph is not designed to allow for suctioning and removal of debris from the distal trachea or oropharynx. The examiner notes that this limitation is functional and that the device of Joseph is capable of performing this function, especially since Joseph distinctly claims suctioning these areas (see at least claim 10). The examiner's arguments regarding Wood are the same as presented above and therefore the examiner maintains the rejection of Joseph and Wood over the presented claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4,385,891 shows another example of suction canister with a removable grid.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THEODORE J. STIGELL whose telephone number is (571)272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Theodore J Stigell/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763